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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,238	11/19/2003	Thomas Viebach	03213616	9908
26565 7590 08/10/2007 MAYER, BROWN, ROWE & MAW LLP 71 S. WACKER CHICAGO, IL 60606			EXAMINER KASZTEJNA, MATTHEW JOHN	
			ART UNIT 3739	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,238

Applicant(s)

VIEBACH ET AL.

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 7-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-9 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Notice of Amendment

In response to the remarks filed on May 14, 2007, amended claim 1 is acknowledged. The current rejections of the claims are *withdrawn*. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1-3 and 7-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing bending elements for bending the distal end of an endoscope tube, does not reasonably provide enablement for providing bending elements for tilting the endoscope head relative to the endoscope shaft. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Claim 1 recites receiving means, for receiving bending elements "for tilting the endoscope head relative to the endoscope shaft." It is unclear from the specification how the endoscope head tilts relative to the endoscope shaft. According to page 4, lines 12-15 of the specification, the bending elements are used to bend the entire distal end of the endoscope tube and not merely to tilt the endoscope head with respect to the endoscope shaft as claimed in the instant invention. The remaining claims are necessarily rejected as being dependant upon a rejected base claim.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Paten No. 5,398,670 to Ortiz et al.

In regard to claim 1, Ortiz et al. disclose an endoscope head equipped with a plurality of function-related units comprising units such as an optical/lens system 70, 72, and illuminating elements 74, wherein the endoscope head comprises a number of modular function-related supports that receive and/or form the function-related units, the endoscope head further comprising function-related supports including a plate-shaped support member for receiving electronic components, a retaining/holding element for an optical/lens system having at least one lens, a protection cap 29a for covering the

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retaining/holding element and the support member, and a mounting adapter 20 for attaching the endoscope head to an endoscope shaft 30, and wherein the mounting adapter is adapted to provide and/or enable all connections between conduits and/or passages formed in the endoscope shaft and the function-related units of the endoscope head (see Fig. 3), and wherein the mounting adapter consists of two concentric coincident cylinder elements having different radii which are interconnected via an adapter plate which is formed on a front side of both cylinder elements such that a cavity in the form of a circle segment is formed between the cylinder elements which segment is divided into three sections by radial ribs, wherein the three sections comprise receiving means, respectively for receiving bending elements for tilting the endoscope head relative to the endoscope shaft (see Figs. 7-8 and 11-14).

In regard to claim 2, Ortiz et al. disclose an endoscope head, wherein the function-related supports are adapted to correctly place or make operative the function-related units preferably automatically by assembling the function-related supports (see Figs. 1 and 3 and Col. 7, Lines 3-26).

In regard to claims 3 and 9, Ortiz et al. disclose an endoscope head, wherein the function-related supports preferably have elastically deformable connecting portions adapted to be brought into predetermined engagement with each other for a snap and/or clamping connection (see Figs. 3 and 8 and Col. 5, Lines 4-18).

In regard to claims 7 and 13-14, Ortiz et al. disclose an endoscope head, wherein on a first side facing the mounting adapter the function-related support has electrical contact surfaces adapted to be brought into contact with the electrical contact

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points of the mounting adapter when the function-related support is assembled with the mounting adapter, wherein electronic components arranged on a second side of the function-related support opposite to the electrical contact surfaces may be supplied with electric current by the electrical contact points via the electrical contact surfaces (see Fig. 3, Col. 7, Lines 3-26 and Col.9, Lines 1-60).

In regard to claim 8, Ortiz et al. disclose an endoscope head, wherein the retaining/holding element for the optical/lens system is attached to the first side of the function-related support on which is arranged the electronic components and which includes at least one chamber receiving the optical/lens system which is open toward a side of the retaining/holding element facing the protection cap and which is aligned with the function-related support above a camera chip 70 provided in the function-related support when the function-related supports are assembled (see Fig. 3).

In regard to claims 11-12, Ortiz et al. disclose an endoscope head, wherein the mounting adapter is adapted to form a mechanical connection between the endoscope head and an endoscope shaft, and to provide and/or ensure a connection between conduits and/or passages formed in the endoscope shaft and function-related units of the endoscope head (see Figs. 1-4, 8-9 and Col. 10, Lines 11-56).

Allowable Subject Matter

Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to claims 1-3 and 7-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

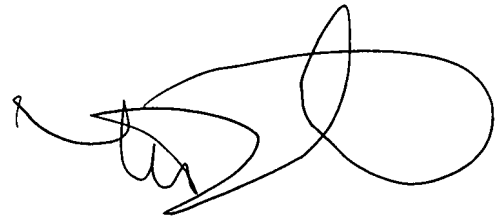
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK

7/30/7



LINDA C. M. DVORAK
SUPERVISORY PATENT EXAMINER
GROUP 3739